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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

ITL.0907US (P15299)

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on March 23, 2006

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Nancy Meshkoff

Application Number

10/616,895

Filed

July 10, 2003

First Named Inventor

Robert P. Meagley

Art Unit

1752

Examiner

Richard L. Schilling

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐

attorney or agent of record.

Registration number

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 55,238

Signature

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March 23, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:

Robert P. Meagley et al.

Serial No.: 10/616,895

Filed: July 10, 2003

For: Photodefinable Polymers for
Semiconductor Applications

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Art Unit: 1752

Examiner: Richard L. Schilling

Docket: ITL.0907US
P15299

Assignee: Intel Corporation
Sumitomo Bakelite Company

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR PRE-APPEAL BRIEF CONFERENCE AND ACCOMPANYING
ARGUMENT**

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, please consider this submission as a request for a pre-appeal brief conference with accompanying arguments.

No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

Date of Deposit: March 23, 2006

I hereby certify that this document is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. 571/273-8300) on the date indicated above.


Nancy Meshkoff

REMARKS

1. **Should the Examiner have Maintained the Provisional Obviousness-Type Double Patenting Rejection?**

The examiner has provisionally rejected each of the claims on the ground of nonstatutory obviousness-type double patenting, as being unpatentable over claims 20 and 21 of copending application 10/337,575. The copending application has an earlier filing date than this application. When the application at issue is the later filed application the applicable test is whether “the invention defined in the claim of the application would have been an obvious variation of the invention defined in a claim in the patent.” See M.P.E.P. § 804(II)(B)(1)(a) at page 800-22 (Emphasis added). To be an obvious variation only the claims are considered—the invention defined in a claim of an application has to be an obvious variation of the invention defined in the claim of a patent. M.P.E.P § 804 at page 800-21. The disclosure of the patent may not be used as prior art when determining an obvious variation. *Id.*

But the examiner has done exactly that—based his determination of double patenting on what is found in the specification. For example, in the final Office action the examiner remarks:

The amendments to the claims limiting the filler to zirconia does not overcome the rejection since the claims of 10/337,575 reasonably include the filler as disclosed as suitable in the *specification* wherein zirconia is disclosed.

Paper No. 125, page 2. The claims of the 10/337,575 application do not expressly cover zirconia. Since the claims in the 10/337,575 application do not specifically claim zirconia, and zirconia is not an obvious variant of what is claimed, then the present claims are not obvious over claims 20 and 21 of the ‘575 application.

In sum, a provisional obvious-type double patenting rejection is to prevent an extension of the right to exclude. M.P.E.P. § 804 at page 800-11. Because the use of zirconia as claimed in this application is not an obvious variation of the claims 20 and 21 of the 10/337,575 application the right to exclude would not be extended.

2. Has the Examiner Established *Prima Facie* Obviousness In View of the Applicant's Evidence to the Contrary?

In addition to the provisional obviousness-type double patenting rejection, the examiner rejected each of the claims under 35 U.S.C. §103(a) as being unpatentable over Sezi in view of Hattori.

Sezi does not teach the use of zirconia as a filler. Paper No09032004, page 4. In view of the declaration by one of the applicants, there is no reason to believe that the claims so rejected would have been obvious to one of ordinary skill in the art.

In the declaration received by the USPTO on November 7, 2005, the inventor explains that he and his coinventors initially used silica as a filler material during the course of the development of the photodefinable polymers that are set forth in this application. Declaration, ¶ 2. Silica showed thixotropy or varying viscosity with shear rate. *Id.* The inventors then tried zirconia. *Id.* at ¶ 3. Unexpectedly, when zirconia was used as a filler material the thixotropy was greatly reduced. *Id.* That zirconia would greatly reduce thixotropy was completely unexpected. *Id.*

The inventor's declaration establishes that the use of zirconia as a filler material greatly reduced thixotropy in the photodefinable polymers that the inventors were developing. The reductions observed by the inventors were unexpected. Thus the use of zirconia, in and of itself, gave an unexpected result. This alone rebuts the examiner's assertion of *prima facie* obviousness. This is, if a compound is unexpectedly superior in one of a spectrum of common properties *prima facie* obviousness may be rebutted. M.P.E.P. § 716.02(a)(II) at page 700-268. No set number of examples of superiority is required. *Id.* at 700-269.

Thixotropy may be undesirable in some photodefinable polymers. The applicants have shown that zirconia has a superior ability to reduce thixotropy over the use of other filler materials such as silica. Therefore, the examiner's maintenance of the 103(a) rejection is believed to be in error.

In the final Office action, the examiner asserts that the declaration is unconvincing due to the lack of detail. It is unclear why any details are needed. The point is not whether specific details of the declaration render the claimed invention obvious or not, but instead that the use of zirconia, in and of itself, renders the claims non-obvious over prior art (which teaches silica).

Thus there is no reason to give additional details because the point is that, generically, silica cannot render obvious the claimed invention to zirconia in these circumstances.

The examiner also asserts that the declaration is not convincing because there is no basis in the specification for the property of thixotropy being important or critical to the invention. But the applicant is not required to place anything in the specification to support unobviousness. M.P.E.P. § 716.02(f). Obviousness is determined by the totality of the record including evidence offered during prosecution. *Id.* The evidence offered in this case demonstrates that thixotropy occurred when silica was used as a filler material and that zirconia greatly reduced thixotrophy. Therefore, it does not matter whether the specification indicates that thixotropy is important or critical.

The examiner is also unconvinced because, in his view, the specification discloses silica and zirconia as equivalents. Again, the M.P.E.P. expressly indicates that there is no requirement that any of the arguments of non-obviousness be placed in the specification. M.P.E.P. § 716.02(f). Since the best mode is disclosed, the fact that advantages to one or the other species is not discussed in the specification is of no importance as the advantages of zirconia are discussed in the declaration.

The examiner's last reason for remaining unconvinced is focused on the specification. But the test is whether the affidavit indicates effectiveness over the entire claimed range. See M.P.E.P. § 716.02(d). Here, the showing in the declaration is broader than the claims and shows that, over the entire range and a broader range, zirconia would unexpectedly be more effective than silica. Thus there is no requirement that a showing wherein zirconia is generically unexpectedly better needs to be supplemented by showing that, in each individual case claimed, zirconia is better. It is better in general and, therefore, it is better in specific.


The specification page 2, lines 17-23 state that, in one embodiment, the particle size of the filler is less than 100 nanometers and that the filler may be zirconia particles which is the same range and material as claimed. An embodiment including zirconia particles with a particle size of less than 100 nanometers exhibits greatly reduced thixotropy. Greatly reduced thixotropy is due to the use of zirconia, not the particle size. This is evidenced by the declaration that states the inventors were contemplating the use of silica and when zirconia was tried the thixotropy was reduced.

In sum, the declaration submitted by one of the inventors rebuts the examiner's assertions of obviousness. Apparently the examiner is not convinced because, in his view, the declaration and specification are of different scope. The specification is not required to address issues of non-obviousness. But in this case the declaration is offered for just that reason: to show non-obviousness. Thus both the specification and the declaration should be considered for what they offer.

Because the examiner erred in his rejection of the claims the committee is requested to withdraw finality and allow the case to pass to issue.

Respectfully submitted,

Date: 3-23-06


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